241

3724

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:
Martin Brady

Serial No.: 09/228,109

Filed: January 11, 1999 Examiner: Jason D. Prone

Docket No.: 0166 Art Unit: 3724

For: HOUSEHOLD KITCHEN OPENING APPLIANCE

Commissioner for Patents
Box 1450
Alexandria, Virginia 22313-1450

RESPONSE TO OFFICE ACTION DATED APRIL 8, 2004

Remarks

Reconsideration of this application is respectfully requested.

Claims 3-5 and 7-15 are pending in this application. On June 18, 2003, claims 3, 7 and 10-13 were finally rejected and claims 4, 5, 8, 9, 14 and 15 were indicated allowable.

By an Action dated April 8, 2004, in response to an appeal Brief filed February 26, 2004, the indication of allowability of claims 4, 8, 14 and 15 was withdrawn; claims 8, 10, 11, 14 and 15 were rejected for the first time under 35 U.S.C. 112, second paragraph; claims 3, 4, 7, 8, and 10-14 were rejected for the first time under 35 U.S.C. 102(e); and a rejection of claims 3, 7

and 10-13 under 35 U.S.C. 103(a) was repeated. Claims 5, 9 and 15 were indicated to contain allowable subject matter but to require amendment due to the rejections of parent claims.

All of the previously-pending claims are presented herewith without amendment because counsel believes that the various grounds for rejection are improper.

Considering the rejections in the same order raised by the examiner, counsel respectfully asks that the rejection of claims 8, 10, 11, 14 and 15 under 35 U.S.C. 112, second paragraph, be withdrawn. Each of these rejections involves use of the phrase "a scissors" as part of the recitation of a claim element. Thus, claim 8 recites "a sheath for **a scissors** on the back of the housing." The examiner does not explain why this phrase renders claim 8 subject to rejection under Section 112; counsel suspects that claim 8 was mistakenly included in the list of claims rejected under Section 112. The real "problem" occurs in dependent claim 14, which recites "a pair of cooperating clamp members for releasably retaining **a scissors** within said sheath." The examiner asserts that the latter recitation is unclear because it is "uncertain if it is the same 'scissors' as disclosed...in claim 8". However, claims 8 and 14 do not recite any scissors, only elements (sheath in claim 8; clamp members in

claim 14) that are associated with a scissors. Whether or not it is the same scissors or not is not a proper inquiry because no scissors is recited in claim 8 or in claim 14. The same comments apply to claim 15, also dependent on claim 8, which recites "a pair of cooperating spring metal clamp members for releasably retaining **a scissors** within said sheath."

Claims 10 and 11 involve essentially the same issue. Claim 10 recites "a scissors holder...capable of releasably retaining **a scissors**..." (As with claim 8, counsel believes that claim 10 was improperly included in the claims rejected under Section 112.) As for claim 11, which depends on claim 10, the examiner finds fault with "a sheath for **a scissors** on said housing" because it is uncertain if it is the same scissors referred to in the portion of claims 10 typed in bold print above. Again, since neither claim 10 nor claim 11 recites "a scissors" as an element of the claim, it is illogical to inquire as to whether the second appearance of the phrase "a scissors" refers to the same or to a different scissors.

The rejection of claims 3, 4, 7, 8, and 10-14 under 35 U.S.C. 102(e) is based on design patent no. D417,129, which issued to Martin Brady, the inventor named herein, and to a joint inventor, Anthony V. Cruz. At the time of the invention, both

inventors were employees of a common assignee, Hamilton Beach/Proctor-Silex, Inc., of the design patent and this application. The problem arises in this case that the application for the design patent was filed before the instant application and names two inventors whereas the instant application identifies only the single inventor. Counsel's understanding of the circumstances is that Martin Brady is the inventor of the utilitarian aspects of the opening appliance to which this application is directed and was also heavily involved in the design of the opening appliance. Mr. Cruz refined parts of Mr. Brady's design and has said Mr. Brady was the only inventor of the utilitarian aspects of the opening appliance. Counsel is attempting to obtain evidence to substantiate the reasons why only Mr. Brady is named as an inventor in the instant application and hopes to submit evidence within a short period of time.

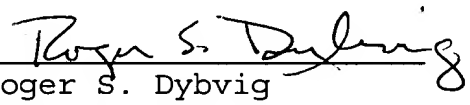
The rejection of claims 3, 7 and 10-13 under 35 U.S.C. 103(a) is based on a combination of references, Presto, Davies, and Nielsen et al., which counsel addressed in the Appeal Brief filed February 26, 2004. The examiner's response to counsel's arguments is confusing in that the examiner stated that counsel's arguments "are moot in view of the new ground(s) of rejection"

yet no new grounds for rejection under Section 103(a) have been advanced by the examiner subsequent to the filing of the Appeal Brief on February 26, 2004. The examiner also quotes from the Davies patent that "the holder can be positioned exactly where it is most convenient" and argues the quoted language includes the back of any appliance. What the examiner fails to recognize is that a disclosure so broad as Davies's disclosure does not constitute a disclosure of each possibility.

With regard to the claims, nos. 5, 9 and 15, indicated to contain allowable subject matter, no amendment is necessary at this time in view of the foregoing remarks.

Favorable action is requested.

Respectfully submitted,



Roger S. Dybvig
Registration No. 19,319
22 Green Street
Dayton, Ohio 45402
(937) 461-1142